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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,782	02/05/2004	Shuhei Sakai	FUJM 20.945	7890
26304	7590	07/11/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			HYEON, HAE M	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			2839	

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,782

Applicant(s)

SAKAI ET AL.

Examiner

Hae M. Hyeon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11 and 16-33, drawn to a power supply terminal having an electronic part **without** a pair of electrodes, classified in class 439, subclass 709.
 - II. Claims 12-15 and 22-28, drawn to a surface mounting component **with** a pair of electrodes, classified in class 439, subclass 620.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the power supply terminal can be used with a solder attached component instead of the surface mounting component of the Invention II using an elastic force. Also, the power supply terminal of the Invention I can have an electronic part with or without a pair of electrodes. The subcombination has separate utility such as use the electronic part of the Invention II in other electronic device other than the power supply terminal of the Invention I.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

ELECTION OF SPIECES

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Figures 1-5 deal with a power supply terminal having an electronic part with plate springs.
- Figure 6 deals with an electronic part having a plate spring with an engaging projection and a press fit terminal with an engaging hole for receiving the engaging projection.
- Figures 7-9 deal with an electronic part having a metallic frame with a rectangular hole, engaging pieces and an engaging projection; and a press fit terminal with slots for receiving a power supply terminal.
- Figures 10 and 11 deal with a surface mounting type capacitor having plate springs, wherein one on the plate spring is pressed against the conductor pattern of the back wiring board.
- Figures 12-15 deal with a capacitor fitted in a notch of a second terminal block, wherein the notch includes a pair of projections formed on wall surfaces of the notch.
- Figure 16 deals with a capacitor connected to a screw and a conductor pattern of a back wiring board without using a second terminal block. The capacitor is connected to the screw by a coil spring.
- Figure 17 deals with a capacitor connected to a screw and a conductor pattern of a back wiring board without using a second terminal block, and using two coil-springs attached to two opposite sides of the capacitor.
- Figures 18 and 19 are similar to Figures 16 and 17, but uses two S-shaped plate spring.

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- Figure 20 deals with a capacitor connected to a screw and a conductor pattern of a back wiring board using a conductive rubber.
- Figure 21 is similar to Figures 16 and 17, but uses a coil spring engaging metallic part to prevent a capacitor from falling off.
- Figure 22 is similar to Figures 18 and 19, but uses S-shaped plate spring inserted into a groove from a horizontal direction to temporarily fix the plate spring.
- Figure 23 deals with a capacitor connected to a screw and a conductor pattern of a back wiring board using distinct shape of plate springs.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Response to Arguments

7. In the Election/Restrictions filed on March 3, 2005, the examiner believes that the grouping of the inventions was not proper. Therefore, the examiner has regrouped the inventions.

8. In the response to the Election/Restrictions filed on March 3, 2005, the applicant has elected the invention, but the applicant has not elected the species election requirement. The applicant is reminded to not only elect the invention, but also the species from the elected invention group.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hae M. Hyeon whose telephone number is 571-272-2093. The examiner can normally be reached on Mon.-Fri. (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tulsidas C. Patel can be reached on (571) 272-2098. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hae M Hyeon
Primary Examiner
Art Unit 2839

hnh

hnh

Hae Moon Hyeon